

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

020366-092000US

I hereby certify that this correspondence is being filed via EFS-Web with the United States Patent and Trademark Office, Attn: Mail Stop AF.

on October 2, 2008.

TOWNSEND and TOWNSEND and CREW LLP

Signature /Joni E. Peterson/Typed of printed name Joni E. Peterson

Application Number

10/632,661

Filed

August 1, 2003

First Named Inventor

Steven M. Casey

Art Unit

2167

Examiner

Robert M. Timblin

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.
/William J. Daley/
☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Signature

William J. Daley

Typed or printed name

☒ attorney or agent of record.
Registration number 52,471
(303) 571-4000

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. _____

October 2, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

I hereby certify that this correspondence is being filed via
EFS-Web with the United States Patent and Trademark Office
on October 2, 2008.

TOWNSEND and TOWNSEND and CREW LLP

By: /Joni E. Peterson/
Joni E. Peterson

**STATEMENT OF REASONS IN
SUPPORT OF PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

PATENT
Attorney Docket No.: 020366-092000US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Steven M. Casey

Application No.: 10/632,661

Filed: August 1, 2003

For: SYSTEMS AND METHODS FOR
IMPLEMENTING A CONTENT
OBJECT ACCESS POINT

Customer No.: 20350

Confirmation No.: 3558

Examiner: Robert M. Timblin

Art Unit: 2167

**STATEMENT OF REASONS IN
SUPPORT OF PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

***Via EFS-Web
Mail Stop AF***
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This statement is submitted in support of the Pre-Appeal Brief Request for Review, that is submitted herewith. The applicants respectfully request review of the final rejection mailed by the U.S. Patent Office for the above-identified application on July 3, 2008 ("the Final Office Action").

A Notice of Appeal is being filed concurrently herewith.

1. Status of Claims

Claims 10, 17, and 23-25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Pub. No. 2001/0034754 of Elwahab et al. (hereinafter "Elwahab"); claims 11-14 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Elwahab as applied to claims 10, 17, and 23-25, in view of U.S. Patent No. 6,576,981 to Jeffrey (hereinafter "Jeffrey"); and claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Elwahab and Jeffrey as applied to claims 11-14, and 16, in view of U.S. Patent No. 6,611,840 to Baer et al. (hereinafter "Baer").

2. Reasons for Requesting Review

35 U.S.C. § 102 Rejection, Elwahab

Claims 10, 17, and 23-25 are rejected under 35 U.S.C. §102(b) as being anticipated by Elwahab. The Applicants respectfully submit the following arguments pointing out significant differences between claims 10, 17, and 23-25 submitted by the Applicants and Elwahab.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully argue that Elwahab fails to disclose each and every claimed element. For example, Elwahab fails to disclose, either expressly or inherently, "abstracting the data type of the first content object" (emphasis added) as recited in claim 10. Additionally, Elwahab fails to disclose, either expressly or inherently, "providing a guide, wherein the guide indicates the first plurality of content objects" as recited in claim 18.

Elwahab is directed to "a Markup-Language-type content server used in conjunction with a customer premise gateway, via Markup-Language-type pages (e.g., HTML, XML, and the like), remote access and control of smart devices, appliances, personal computers, and other devices and systems connected at a customer premise via different communication

means and protocols." (para. 3) That is, Elwahab discloses a system for allowing a user to remotely control appliances within his home, e.g., HVAC, lighting, security system. (para. 9).

As defined for example on page 5, paragraph 20 of the detailed description of the pending application, a content object is defined as "content maintained as an accessible object that can be accessed, utilized, and/or stored." Furthermore, examples of such content "include, but [are] not limited to, traditional content including movies, music, games, voicemails, emails, software, security video, emergency alerts, and any other content that comes to the home or can be requested from the network via providers." (para. 24) Elwahab does not disclose abstraction or distinction of such content. For example, Elwahab does not disclose abstraction or distinction of video objects, audio objects or "other content that comes to the home of can be requested from the network via providers." Rather, Elwahab describes a system for allowing a user to remotely control appliances within his home, e.g., HVAC, lighting, security system. Furthermore, Elwahab does not disclose abstracting a first content object from a first content object entity in a format compatible with a first content object entity into a second content object in an abstract form distinguishing the second (abstract) content object to create a third content object in a second content format that is compatible with a second content object entity and different from the first content format.

In response to these arguments, the final Office Action continues to rely on the argument that the claims are given their broadest reasonable interpretation and that Elwahab is seen to disclose such content objects in light of their meaning gleaned from the specification. The Applicants respectfully maintain that such an interpretation of the claims is overly broad and not reasonable in light of the specification. As noted above, content objects are clearly defined to be content sent to the home or requested from a network via providers. This definition clearly encompasses the explicit examples of video and audio content as enumerated in the specification and as commonly known in the art and in everyday usage. As detailed above, Elwahab does not disclose video, audio or any other content object sent to the home or requested from a network via providers. Rather, Elwahab describes a system for allowing a user to remotely control

appliances within his home, e.g., HVAC, lighting, security system. These items do not comprise content object sent to the home or requested from a network via providers.

Claim 10, upon which all currently pending claims depend, recites in part, "accessing a first content object from a first content object entity within the customer's premises, wherein the first content object is in a first content format compatible with the first content object entity; abstracting the data type of the first content object to create a second content object in an abstract format, wherein the abstract format is compatible with a plurality of content formats; distinguishing the data type of the second content object to create a third content object, wherein the third content object is in a second content format that is compatible with a second content object entity within the customer's premises and different from the first content format."

Elwahab does not disclose, either expressly or inherently, abstracting a first content object from a first content object entity in a format compatible with a first content object entity into a second content object in an abstract form and distinguishing the second (abstract) content object to create a third content object in a second content format that is compatible with a second content object entity and different from the first content format. Rather, Elwahab describes a system for allowing a user to remotely control appliances within his home, e.g., HVAC, lighting, security system. For at least these reasons, the rejection is improper and should be withdrawn.

35 U.S.C. § 103 Rejections, Elwahab in view of Jeffrey

The Office Action has rejected claims 11-14 and 16 under 35 U.S.C. §103(a) as being unpatentable over Elwahab as applied to claims 10, 17, and 23-25 above, in view of Jeffrey. As discussed above, claim 10, upon which claims 11-14 and 16 depend is thought to be allowable. Therefore, claims 11-14, and 16, are also thought to be allowable at least by virtue of their dependence on an allowable base claim. For at least these reasons, the Applicants request withdrawal of the rejection.

Application No. 10/632,661

PATENT

Statement of Reasons in Support of Pre-Appeal Brief Request for Review

Date: October 2, 2008

35 U.S.C. § 103 Rejections, Elwahab and Jeffrey and further in view of Baer

The Office Action has rejected claim 15 under 35 U.S.C. §103(a) as being unpatentable over Elwahab and Jeffrey, as applied to claims 11-14, and 16 above, in view of Baer. As discussed above, claim 10, upon which claim 15 depends, is thought to be allowable. Therefore, claim 15 is also thought to be allowable at least by virtue of its dependence on an allowable base claim. For at least these reasons, the Applicants maintain that the rejection is improper and should be withdrawn.

Respectfully submitted,

Date: October 2, 2008

/William J. Daley/
William J. Daley
Reg. No. 52,471

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: 303-571-4000 (Denver)
Fax: 303-571-4321 (Denver)
WJD:jep
61509303 v1